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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/630,141 | 07/30/2003 | John J. Giobbi | 47079-00107USD2 | 9474 |
| 70243 7590 10/16/2008 NIXON PEABODY LLP 161 N CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213 | | | | |
| EXAMINER | | | | |
| YOO, JASSON H | | | | |
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| 3714 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,141

Applicant(s)

GIOBBI, JOHN J.

Examiner

Jasson H. Yoo

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 101-104 and 106-125 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 101-104 and 106-125 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/14/08 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 101-104, 106-125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedrick et al. (US 6,908,387) in view of Rantze (US 6,536,658) as supported by Sizer et al. (US 5,923,252).

101, 102, 111-112, 116, 120-122. Hedrick discloses a method of operating a gaming terminal by establishing a wireless transmission link with a portable data unit carried by an individual (cols. 5:56-6:6, 10:45-56, 17:44-18:2). The portable data unit transfers player tracking information to the gaming machine. Thus the portable data

unit must store player information in order to transfer the player tracking information to the gaming machine (col. 17:44-51.). The player tracking information is used during a player tracking session to associate player's game play with the player's account (col. 17:34-18:5). The gaming machine detects the portable data unit within a predetermined distance (cols. 10:57-11:25). Hedrick also discloses the gaming machine operates in an attract mode upon sensing a player in proximity of the gaming machine (col. 12:23-30). However, Hedrick fails to teach the attract mode occurs in response to detecting a portable data unit carried by a user within a first predetermined distance or time, and a play mode occurs in response to detecting a portable data unit carried by a user within a second predetermined distance or time, wherein the first distance or time is different than the second predetermined distance or time. Nevertheless, the method of operating a device in different modes is well known in the art. In an analogous art to automatically detecting users to operate a device, Rantze discloses a method of changing operation modes depending on the actual distance of a user and movement of the user (abstract, cols. 2-4, 11:38-53). More specifically, Rantze discloses a method of operating retail terminal such as a kiosk. When a person is at a predetermined distance, the kiosk would operate in an attract mode by playing a sound clip (col. 2:41-45). As the user approaches the kiosk, the information on the screen changes (col. 2:46-48). Rantze's method of operating the kiosk at different modes based on different distances allows the apparatus to operate more effectively by accommodating the user. Therefore it would have been obvious to one of ordinary skilled in the art at the time invention was made to modify Hedrick's method of operating a gaming terminal by establishing a wireless

transmission link with a portable data unit and incorporate Rantze's method of operating a device differently based on the user's distance in order to operate the gaming device more effectively based on the user's location.

It is noted that Hedrick's detection method involves a portable device unit (as claimed) whereas Rantze's detection method involves a transmitter to transmit waveforms of different frequencies that reflect from objects around the operating device. However the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. Rather, the test is what the combined teaching of those references would have suggested to those of ordinary skill in the art. *In re Keller*. See MPEP 2145 III *Arguing that prior art devices are not physically combinable*. In this case, as discussed above, Rantze reference is relied upon to teach the method of operating a device at different modes based on different distances. One of ordinary skilled in the art would know how to modify's Hedrick's detection system and incorporate Rantze's method of operating a device at different modes based on different distance accordingly. Furthermore, Hedrick's system and Rantze's system are both directed to a detection system to operate a device. One of ordinary skilled in the art would know that the specific type of detection system (i.e. using a card, transmitter, etc.) can be substituted for another. This is also taught by Sizer. Sizer discloses a system where a device (audio and video device) is operated based on the detection of a person. More specifically Sizer discloses audio and video messages are provided to a person upon the detection of the person (see abstract). Different messages can be provided depending upon the location of the person (col.

17:1627). Sizer discloses different type of detection means can come in many form (cols. 3:57-67, 64-17).

Hedrick in view of Rantze further discloses the following:

103, 114. Receiving a wager from the passer by (Hedrick, cols. 17:44-18:19).

104. Operating the gaming machine in a first mode includes inviting the passerby to play the gaming machine (attract mode as discussed above).

106, 123. Inviting the passerby, based on the identity of the passerby, to play the gaming machine (Hedrick, col. 12:23-30, 12-36-59, 17:36-18:19).

107, 117. Operating the gaming machine in a first mode includes inviting the passerby based on the identity of the passerby, to play the gaming machine (see rejection for claims 102 and 106 above).

108, 113. Encrypting data communicated across the wireless communication link into ciphered data (col. 15:34-38).

109, 115. Operating the gaming machine in a first mode includes attracting the passerby to interact with the gaming machine (As discussed above in claim 102,

Hedrick discloses an attract mode. This attract mode may cause the player to interact with the gaming machine.).

110, 118, 124. Attracting the passerby includes the gaming machine conveying a message to the passerby (Hedrick discloses a message in lights or sound to convey the message that the gaming machine wants attention to the player, col. 12:27-30).

119, 125. Hedrick in view of Rantze discloses the method of method of operating a gaming terminal by establishing a wireless transmission link with a portable data unit but fails to specifically teach modifying the operating of the gaming machine according the play mode includes disregarding individuals with a portable data unit who pass by the gaming machine at greater than for at least one of the second predetermined distance or disregarding individual who pass by the gaming machine for less than second predetermined period of time. Nevertheless, such limitations would have been obvious to one of ordinary skilled in the art. Hedrick in view of Rantze discloses a method of operating a gaming terminal in which operations modes are changed according the distance of the user. The operations modes are changed because the gaming terminal performs one mode at a time. When the gaming terminal is in play mode, the gaming terminal is occupied by the player. Switching the mode while a player is in play mode with the gaming terminal will disrupt the player's game. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Hedrick in view of Rantze's method of method of

operating a gaming terminal and disregard individuals with a portable data unit who pass by the gaming machine in order to not disrupt the game that's in play.

Response to Arguments

Applicant's arguments filed 7/14/08 have been fully considered but they are not persuasive.

In response to applicant's argument that Rantze is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Applicant's invention is directed to a gaming machine that operates in different modes based on the detection of a person. A gaming machine is device that provides service to a person. Similarly, Rantze's invention is directed a service providing systems (retail terminal, such as kiosk, see abstract). Furthermore, the Applicant's field of endeavor is directed to a device that operates in different modes based on the detection of a person. This is analogous to Rantze's field of endeavor where a device operates in different modes based on the detection of a person.

Applicant additionally argues that Hedrick's detection method involves a portable device unit (as claimed) whereas Rantze's detection method involves a transmitter to transmit waveforms of different frequencies that reflect from objects around the operating device. Thus there is no motivation to combine the references and one of

ordinary skilled in the art would not combine the references. However the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. Rather, the test is what the combined teaching of those references would have suggested to those of ordinary skill in the art. See rejection above for a detailed explanation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 9:00am - 5:00am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Supervisory Patent Examiner, Art Unit 3714

JHY